

REMARKS

The claims remaining in the present application are Claims 1-23. Claims 1-2, 4-6, 9-12, 19-20 and 23 have been amended. The instant specification has been amended. No new matter has been added as a result of these amendments.

35 U.S.C. §102

Claims 1-3, 6, 8-10, 15-17, 19-21 and 23 are rejected under 35 U.S.C. §102 as being anticipated by Nejedlo et al., U.S. Published Patent Application 2004/0117709 (hereinafter, Nejedlo). The rejection to Claims 1-3, 6, 8-10, 15-17, 19-21 and 23 is respectfully traversed for the reasons below.

Currently Amended Claim 1 recites, in part:

a) transferring a test pattern between a first data controller coupled to a first external data interface of said electronic device and a second data controller coupled to a second external data interface of said electronic device via an element external to said device and coupling said first and second external data interfaces.

Applicants respectfully assert that the rejection fails to present a prima facie case of anticipation in that the rejection fails to specifically point out what elements in Nejedlo allegedly teach each and every claim limitation. The rejection relies upon paragraph 28 of Nejedlo, which refers to Figure 2, as teaching the above claim limitations.

Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim (Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co., 221 USPQ 481, 485 (Fed. Cir. 1984) (emphasis added)).

Applicants respectfully request that the rejection point out specific elements in the reference that allegedly teach each claim limitation, such that the Applicants are able to clearly understand the rejection, per requirements set forth in Title 37 of the Code of Federal Regulations.

In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command. When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified (37 C.F.R. §1.104 (c)(2) (emphasis added)).

Applicants respectfully assert that the rejection fails to comply with the legal requirements set forth in 37 C.F.R. §1.104 (c)(2) in that the rejection fails to designate as nearly as practicable the particular part of the reference relied upon. Applicants respectfully assert that it would be practicable for the rejection to point out the specific elements that the rejection relies upon as teaching each and every claim element. As

Applicants have previously discussed, anticipation requires the

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presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim. Applicants respectfully assert that the rejection must point out what elements of Nejedlo are relied on for each and every element in the claim in order to comply with legal requirements of Federal Statutes and Federal Case Law.

Because the rejection fails to present a prima facie case of anticipation, the rejection has been overcome. Applicants further traverse the rejection on the grounds that Nejedlo fails to teach or suggest the limitations of Claim 1. Applicants have examined Figure 2 of Nejedlo, as well as paragraph 28, and respectfully assert that Nejedlo fails to teach the above limitations, arraigned as in the claim, there or elsewhere. It is Applicants understanding that the rejection asserts that the I/O buffers in Figure 2 teach the claimed first and second data interfaces. Applicants respectfully asset that Nejedlo does not teach or suggest that a test pattern is transferred via an element external to said device and coupling said first and second external data interfaces, as claimed.

For all of the foregoing reasons, Nejedlo fails to teach or suggest the limitations of claim 1. Therefore, Applicants respectfully request allowance of Claim 1.

Claims 9 and 19 recite similar limitations to those discussed in the response to Claim 1. Therefore, Claim 9 and 19 are respectfully believed to be allowable for at least the reasons discussed therein.

35 U.S.C. §103

Claims 4-5 and 11-12

Claims 4-5 and 11-12 are rejected under 35 U.S.C. §103 as being unpatentable over Nejedlo in view of Marchevsky, U.S. Patent No. 6,572,384 (hereinafter, Marchevsky). The rejection to Claims 4-5 and 11-12 is respectfully traversed for the reasons below.

Applicants respectfully asset that the rejection fails to present a prima facie case of obviousness for at least the reasons discussed in the response to Claim 1.

Furthermore, Applicants traverse the rejection on the grounds that the combination fails to teach or suggest the limitations of Claims 4-5 and 11-12. For reasons discussed above, Nejedlo fails to teach or suggest a test pattern is transferred via an element external to said device and coupling said first and second external data interfaces, as claimed.

Marchevsky fails to remedy this deficiency in that Marchevsky fails to teach or suggest a test pattern is transferred via an element external to said device and coupling said first and second external data

interfaces, as claimed. Applicants respectfully assert that Marchevsky is silent as to the claimed element external to said device coupling said first and second external data interfaces.

For all of the foregoing reasons, the combination of Nejedlo and Marchevsky fails to teach or suggest the limitations of Claims 4-5 and 11-12. Therefore, Applicants respectfully request allowance of Claims 4-5 and 11-12.

Claims 7, 18 and 22

Claims 7, 18 and 22 are rejected under 35 U.S.C. §103 as being unpatentable over Nejedlo in view of Rajska, U.S. Patent No. 5,9915898 (hereinafter, Rajska). The rejection to Claims 7, 18 and 22 is respectfully traversed for the reasons below.

Applicants respectfully asset that the rejection fails to present a prima facie case of obviousness for at least the reasons discussed in the response to Claim 1.

Furthermore, Applicants traverse the rejection on the grounds that the combination fails to teach or suggest the limitations of Claims 7, 18 and 22. For reasons discussed above, Nejedlo fails to teach or suggest a test pattern is transferred via an element external to said device and coupling said first and second external data interfaces, as claimed.

Rajski fails to remedy this deficiency in that Rajski fails to teach or suggest a test pattern is transferred via an element external to said device and coupling said first and second external data interfaces, as claimed. Applicants respectfully assert that Rajski is silent as to the claimed element external to said device coupling said first and second external data interfaces.

For all of the foregoing reasons, the combination of Nejedlo and Rajski fails to teach or suggest the limitations of Claims 7, 18 and 22. Therefore, Applicants respectfully request allowance of Claims 7, 18 and 22.

Claims 13-14

Claims 13-14 are rejected under 35 U.S.C. §103 as being unpatentable over Nejedlo in view of Allen, U.S. Patent No. 6,237,048 (hereinafter, Allen). The rejection to Claims 13-14 is respectfully traversed for the reasons below.

Applicants respectfully asset that the rejection fails to present a prima facie case of obviousness for at least the reasons discussed in the response to Claim 1.

Furthermore, Applicants traverse the rejection on the grounds that the combination fails to teach or suggest the limitations of Claims

13-14. For reasons discussed above, Nejedlo fails to teach or suggest a test pattern is transferred via an element external to said device and coupling said first and second external data interfaces, as claimed.

Allen fails to remedy this deficiency in that Allen fails to teach or suggest a test pattern is transferred via an element external to said device and coupling said first and second external data interfaces, as claimed. Applicants respectfully assert that Allen is silent as to the claimed element external to said device coupling said first and second external data interfaces.

For all of the foregoing reasons, the combination of Nejedlo and Rajska fails to teach or suggest the limitations of Claims 13-14. Therefore, Applicants respectfully request allowance of Claims 13-14.

CONCLUSION

In light of the above listed remarks, reconsideration of the rejected claims is requested. Based on the amendments and arguments presented above, it is respectfully submitted that Claims 1-23 overcome the rejections of record. Therefore, allowance of Claims 1-23 is respectfully solicited.

Should the Examiner have a question regarding the instant amendment and response, the Applicants invite the Examiner to contact the Applicants' undersigned representative at the below listed telephone number.

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